

S3-02P15734 - Application No. 10/534,681  
Response to Office action July 1, 2008  
Response submitted August 28, 2008

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 11-24 remain in the application.

In item 4 on page 2 of the above-identified Office action, claims 18-23 have been rejected as being fully anticipated by Frank et al. (U.S. Patent No. 6,705,587 B1) (hereinafter "Frank") under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Claim 18 calls for, *inter alia*:

a coining ring having a contact surface in contact with the step surface, the coining ring having an annular width and a height stamped by a die to an exact predefined distance from the first component, the annular width being wider than the step width for defining an enlarged contact surface for an effective force between the second component and the step, the end surface of second component being in contact with and resting on the enlarged contact surface.

Claim 18 also calls for, *inter alia*:

a housing having a first bore with a first diameter and a second bore with second diameter larger than the first diameter, and a step formed between the first bore and the second bore, the step having a step width and a step surface.

Claim 18 also calls for, *inter alia*:

a first component fixedly disposed in the first bore.

It is once again noted that the corporate assignee of the Frank reference is also the assignee of the instant application. Therefore, applicants are very familiar with the Frank reference.

The Examiner refers to the annotated Fig. 1 of Frank (provided with the Office action) in support of the rejection over Frank. The following remarks pertain to the Fig. 1 of Frank provided by the Examiner.

It is respectfully noted that the Examiner appears to ignore several limitations recited in claim 18 when considering the Frank reference.

The instant application as claimed recites that a step is formed between the first bore and the second bore, the step has a step width and a step surface.

In Fig. 1 of Frank as provided by the Examiner, the Examiner designates the smallest bore as the "first bore" and a larger bore as the "second bore". However, Frank does not disclose that the bores designated by the Examiner have a step formed between the "first bore" and the "second bore". This is because there is another bore (not labeled by the Examiner) which has a diameter that is larger than the "first bore" and smaller than the "second bore". The "step" designated by the Examiner is formed between this other bore and the "second bore". Therefore, the "step" designated by the Examiner is not formed between the "first bore" and the "second bore", as required in the claims of the instant application.

Accordingly, it is respectfully noted that the Examiner's designation of elements in the attached Fig. 1, are not accurate.

Therefore, as seen from the above-given remarks the reference does not show a housing having a first bore with a first diameter and a second bore with second diameter larger than the first diameter, and a step formed between the first bore

and the second bore, the step having a step width and a step surface, as recited in claim 18 of the instant application.

Moreover, claim 18 of the instant application recites that the first component is fixedly disposed in the first bore. The Examiner alleges that Frank discloses a "first component 6". However, Frank discloses that the element designated "6" is valve lifter. Frank explicitly discloses that the valve lifter (6) moves in an axial direction to open the valve element (7). Therefore, because Frank discloses that the valve lifter (6) moves, Frank does not disclose that the valve lifter (6) is fixedly disposed in the "first bore". This is contrary to the instant application as claimed, which explicitly recites that the first component is fixedly disposed in the first bore.

As seen from the above-given remarks, the reference does not show a first component fixedly disposed in the first bore, as recited in claim 18 of the instant application.

The following further remarks pertain to the designation of elements as shown in the annotated Fig. 2 of Frank provided by the Examiner.

In Fig. 2, the Examiner designates the intermediate element between the injector housing (1) and the housing (3) as the "coining ring".

It is respectfully noted that this designation is lacking for several reason. Firstly the "coining ring" does not have a contact surface in contact with the step surface, as recited in claim 18 of the instant application. Moreover, the "coining ring" does not have an annular width that is wider than the step, as recited in claim 18 of the instant application. Furthermore, the "coining ring" does not have an enlarged contact surface in contact with and resting on the end of a second component, as recited in claim 18 of the instant application.

As seen from the above-given remarks, the reference does not show a coining ring having a contact surface in contact with the step surface, the coining ring having an annular width and a height stamped by a die to an exact predefined distance from the first component, the annular width being wider than the step width for defining an enlarged contact surface for an effective force between the second component and the step, the end surface of second component being in contact with and resting on the enlarged contact surface, as recited in claim 18 of the instant application.

Since claim 18 is allowable over Frank, dependent claims 19-21, 23, and 24 are allowable over Frank as well.

In item 5 on page 2 of the Office action, claims 11-17 have been rejected as being obvious over Frank (U.S. Patent No. 6,705,587 B1) under 35 U.S.C. § 103.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 11 calls for, *inter alia*:

inserting a die with a first reference mark marked thereon and a longitudinal bore formed therein into the second bore, inserting a probe with a second reference mark into the longitudinal bore until the probe contacts the first component, establishing a reference measurement between the first and second reference marks representing a distance between the lower annular surface of the coining ring and the lower side of the first component, and compressing the coining ring with the die until the reference measurement corresponds to a predefined value for the distance.

On page 3 of the Office action the Examiner alleges that "since Frank et al. discloses the structural limitations of the instant invention (see attached Fig. 2), the methods would

have been matters of design choice to accurately position the various components during assembly."

It is respectfully noted that the Examiner's allegation is quite absurd. Particularly, as noted above, the Fig. 2 of Frank provided by the Examiner comes nowhere near meeting the structural requirements of the present invention as claimed. Furthermore, Frank is completely silent with respect to any coining steps. Frank discloses only surface grinding steps and a prestressing device which is screwed in for deforming the compensation collar (9). Frank does not disclose any dies or probes as required in the method of the instant application as claimed. Therefore, it is respectfully noted that the Examiner's allegation with respect to the obviousness rejection of the methods steps, is absurd.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

As seen from the above-given remarks, the reference does not show or suggest inserting a die with a first reference mark marked thereon and a longitudinal bore formed therein into the second bore, inserting a probe with a second reference mark into the longitudinal bore until the probe contacts the first

component, establishing a reference measurement between the first and second reference marks representing a distance between the lower annular surface of the coining ring and the lower side of the first component, and compressing the coining ring with the die until the reference measurement corresponds to a predefined value for the distance, as recited in claim 11 of the instant application.

The references applied by the Examiner **do not** teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Since claim 11 is allowable over Frank, dependent claims 12-17 are allowable over Frank as well.

It is appreciatively noted from item 4 on page 3 of the Office action that claim 22 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claims have not been amended as indicated by the Examiner, as the claims are believed to be patentable in their existing form.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 11 or 18. Claims 11



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and 18 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 11 or 18, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 11-23 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect  
to Sections 1.16 and 1.17 to the Deposit Account of Lerner  
Greenberg Stemmer LLP, No. 12-1099.

Respectfully submitted,

/Alfred K. Dassler/

Alfred K. Dassler  
Reg. No.: 52,794

AKD:sa

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Lerner Greenberg Stemmer LLP  
Post Office Box 2480  
Hollywood, FL 33022-2480  
Tel: (954) 925-1100  
Fax: (954) 925-1101